

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

Claims 1-7 and 9-104 were pending in this application. Claims 15-35, 50-83, and 86-104 were previously withdrawn from consideration. In this Amendment, claims 1, 36, 46, 84, and 85 have been amended. Accordingly, upon entry of this Amendment, claims 1-7, 9-14, 36-49, and 84-85 will still be pending and under consideration.

In the Office Action mailed May 4, 2007, claims 1-7, 36-39, and 42-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,591,103 to Dunn et al. ("Dunn") in view of U.S. Patent No. 5,761,621 to Sainton ("Sainton"); and claims 9-14, 40-41, 44-49 and 84-85 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunn in view of Sainton, in further view of U.S. patent No. 5,159,625 to Zicker ("Zicker") (Applicants assume that the Examiner intended to identify U.S. Patent No. 5,159,625 to Zicker as a reference, rather than No. 6,159,625).

Preliminary Remarks

The Examiner is thanked for the detailed response set forth in the Office Action explaining the Examiner's reading of certain terms of the rejected claims, such as "home network." As discussed below, Applicants have amended the pending claims to more clearly recite such features of the present invention.

Rejection Of Claims 1-7, 36-39, And 42-43 Under 35 U.S.C. § 103(a)

The rejection of independent claims 1 and 36 should be withdrawn because each claim recites at least one feature that is neither taught nor suggested by the cited art. For example,

amended claim 1 recites a method of selecting a wireless network from a plurality of wireless networks available to a wireless device *associated with a subscriber to a home network*, the method comprising, among other things, receiving a service request at the home network from the wireless device, and determining, based on a table of information downloaded from the home network associated with the subscriber to the wireless device, whether one of the plurality of wireless networks can provide the requested service.

In accordance with the present Amendment, the term “home network,” as recited in amended claim 1, is defined in the context of the wireless device subscriber to that network. Applicants believe that neither Dunn nor Sainton disclose the claimed feature of determining, based on a table of information downloaded from the home network associated with the subscriber to the wireless device, whether one of the plurality of wireless networks can provide the requested service. The portions of Dunn cited as teaching this feature disclose a Central Selection Agency (CSA) that is used in common by a plurality of networks. The Central Selection Agency cannot thereby constitute a home network associated with the subscriber, as recited in amended claim 1. On the contrary, Dunn explicitly states that “all the networks share the common control channel and support of the CSA.” (Column 6, lines 8-9.)

Nor do the portions of Sainton relied upon by the Examiner disclose such a feature. The Examiner asserts that Sainton teaches an alternative method for downloading information regarding provider service capabilities to a wireless device. The Examiner alleges that Sainton discloses that information from all providers is compiled and broadcast by a single entity for use in selecting carriers. The Examiner further asserts that it would have been obvious to one of ordinary skill to apply the teachings of Sainton for downloading information to the system of

Dunn. Conceding *arguendo* that these assertions by the Examiner are true, the combination of Dunn and Sainton still fail to disclose or suggest the presently claimed invention, as recited in amended claim 1. The determination of service capabilities recited in amended claim 1 is based on a *table of information downloaded to a wireless device from the home network associated with the subscriber*, not based on some data compiled and broadcast from a single entity common to many service providers.

In view of the above, the combination of Dunn and Sainton fails to render obvious amended claim 1, as presently amended. Applicants therefore respectfully submit that amended claim 1 is patentable over the prior art of record. In addition, Applicants respectfully submit that claims 2-7 are also patentable due at least to their dependence from an allowable base claim.

Similar to the amendments to claim 1, Applicants have amended independent claim 36 to recite a wireless device associated with a subscriber to a home network. In addition, the feature of establishing a connection has been further defined, wherein the establishing the connection comprises establishing a low bandwidth connection between the wireless device and the home network if the wireless device is registered with a roaming service provider. Support for this amendment can be found in the present application, for example, at Figure 3 and at the second paragraph under the heading "Network-Based Selection When Roaming." This feature is neither taught nor suggested by the cited art.

Applicants therefore respectfully submit that claim 36 is patentable over Dunn in view of Sainton. In addition, Applicants respectfully submit that claims 37-39 and 42-43 are also patentable due at least to their dependence from an allowable base claim.

Rejection Of Claims 9-14, 40-41, 44-49, And 84-85 Under 35 U.S.C. § 103(a)

Claims 9-14, which depend from independent claim 1, are patentable over Dunn in view of Sainton at least for the reasons stated above with respect to claim 1. Nor does the periodic downloading of Zicker cure the deficiencies in the teachings of Dunn and Sainton with respect to claims 9-14. Applicants therefore respectfully request that the rejection of claims 9-14 under 35 U.S.C. § 103(a) be withdrawn.

Claims 40-41, which depend from independent claim 36, are patentable over Dunn in view of Sainton at least for the reasons stated above with respect to claim 36. Nor does the periodic downloading of Zicker cure the deficiencies in the teachings of Dunn and Sainton with respect to claims 40-41. Applicants therefore respectfully request that the rejection of claims 40-41 and under 35 U.S.C. § 103(a) also be withdrawn.

Similarly to claim 36, Applicant has amended independent claim 46 to recite a method comprising, among other things, establishing a connection between a wireless device and a home network associated with a subscriber of the wireless device, wherein the establishing the connection comprises establishing a low bandwidth connection between the wireless device and the home network if the wireless device is registered with a roaming service provider. As noted above, this feature is neither taught nor suggested by Dunn nor Sainton. Nor does the periodic downloading of Zicker cure the deficiencies in the teachings of Dunn and Sainton with respect to claim 46. Applicants therefore respectfully submit that claim 46 is patentable over the cited art. In addition, Applicants respectfully submit that claims 47-49 are also patentable due at least to their dependence from an allowable base claim.

Claim 84 has been amended similarly to claim 1 to recite a wireless device of a subscriber associated with a home network. In addition, claim 84 recites the feature of

establishing a parallel communication session with a second network of the plurality of networks to process the service request. Contrary to the Examiner's assertion, Dunn fails to disclose establishing a *parallel communication session* with a second network. The portions of Dunn cited by the Examiner disclose that "the user or originator can program the wireless device to change networks" (column 10, lines 38-39) and that a call "appears as a series of handoffs from network to network" (column 10, lines 43-44). This clearly does not constitute establishing a parallel communication session with a second network, as recited in amended claim 84. This deficiency is not cured by either the teachings of Sainton or Zicker. Applicants therefore respectfully submit that amended claim 84 is patentable over the prior art of record.

Claim 85 has been amended similarly to claim 36 to recite establishing a connection between a wireless device and the home network service provider, wherein the establishing the connection comprises establishing a low bandwidth connection between the wireless device and the home network if the wireless device is registered with a roaming service provider. As noted above, neither Dunn nor Sainton teach or suggest this feature. The same goes for Zicker. Applicants therefore respectfully submit that claim 85 is patentable over the prior art of record.

Change Of Correspondence Address

In response to the rejection of the Change of Correspondence Address filed April 17, 2007, Applicants submitted a Notice of Change of Address on May 8, 2007, which Applicants believe is in compliance with 37 C.F.R. § 1.34(C).

In view of the foregoing, all of the claims pending in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further

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action is desirable to place this application in condition for issue, the Examiner is encouraged to telephone applicants' undersigned representative at the number listed below.

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Respectfully submitted,

GUILFORD ET AL.

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